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HC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/191,199	11/12/98	TANG	238/130

022249  
LYON & LYON LLP  
SUITE 4700  
633 WEST FIFTH STREET  
LOS ANGELES CA 90071-2066

HM22/1124

EXAMINER

COLEMAN, B

ART UNIT	PAPER NUMBER
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1611

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DATE MAILED: 11/24/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

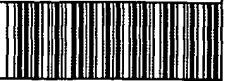
# Office Action Summary

Application No.  
09/191,199

Applicant(s)  
TANG et al.

Examiner  
Brenda Coleman

Group Art Unit  
1611



- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-45 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-45 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

- ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1611

### **DETAILED ACTION**

Claims 1-45 are pending in the application.

#### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 11-16, 18-37 and 41-45, drawn to compounds, compositions, method of use and process of preparing the compounds of formula 1 where one of D, E, F and G is nitrogen and the others are carbon, classified in class 546, subclass 113 and class 514, subclass 300.
- II. Claims 1-6, 9, 11-16, 19-37 and 41-45, drawn to compounds, compositions, method of use and process of preparing the compounds of formula 1 where D and G are nitrogen and E and F are carbon, classified in class 544, subclass 350 and class 514, subclass 249.
- III. Claims 1-16, 19-37 and 41-45, drawn to compounds, compositions, method of use and process of preparing the compounds of formula 1 where D and F or E and G are nitrogen and the others are carbon, classified in class 544, subclass 280 and class 514, subclass 258.
- IV. Claims 1-9, 11-16, 19-37 and 41-45, drawn to compounds, compositions, method of use and process of preparing the compounds of formula 1 where D and E or E and F or F and G are nitrogen and the others are carbon, classified in class 544, subclass 236 and class 514, subclass 248.

Art Unit: 1611

- V. Claims 1-16, 19-37 and 41-45, drawn to compounds, compositions, method of use and process of preparing the compounds of formula 1 where three or four of D, E, F and G are nitrogen, classified in class 544, various subclasses within and class 514, various subclasses within.
- VI. Claims 17, 19-37 and 41-45, drawn to compounds, compositions, method of use and process of preparing the compounds as defined in Table 1. (Note: claim 17 is not a statutory claim in that a claim must be complete within itself and each species must be presented in different claims according to Rule 141(a).
- VII. Claims 38-40, drawn to a combinatorial library.

The inventions are distinct, each from the other because of the following reasons:

Groups I-V are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of D, E, F and G in formula 1 do not belong to a recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others, for example 5,7-diaza-indolinone is different from 5-aza-indolinone, 5,6,7-triaza-indolinone, etc. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structures as functional equivalents of each other. The mere fact that there is a single similarity is not in itself a significant reason to render the whole embodiment obvious.

Art Unit: 1611

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Tentative election of a single species within the elected group is further required.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Art Unit: 1611

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Monday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1611

  
Brenda Coleman  
November 22, 1999